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### **REMARKS**

This is a full and timely response to the outstanding Office Action mailed April 18, 2006. Upon entry of the amendments in this response claims 1-3, 6-8, 15, and 21-45 are pending. More specifically, claims 1, 21, and 35 are amended, and claims 43-45 are added. These amendments are specifically described hereinafter.

#### **I. Present Status of Patent Application**

Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Arnold* (U.S. Patent No. 6,275,848) in view of *Lafe* (U.S. Patent No. 6,449,658). Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda, et al.* (U.S. Patent No. 6,275,850) in view of *Hanson, et al.* (U.S. Patent No. 6,549,957). These rejections are respectfully traversed.

#### **II. Examiner Interview**

Applicant first wishes to express sincere appreciation for the time that Examiner Neurauter spent with Applicant's representative Benjie Balser during a June 12, 2006 telephone discussion regarding the above-identified Office Action. Applicant believes that various features described in the patent application and recited in the claims, including compacting an email for storage, and *Arnold* and *Beyda* were discussed during the telephone discussion, and that the outcome of this discussion is addressed herein. During that conversation, Examiner Neurauter seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Neurauter carefully consider this amendment and response.

#### **III. Rejections Under 35 U.S.C. §103(a) and *Arnold***

##### **A. Claims 1-3, 6-8, 15, and 43**

The Office Action rejects claims 1-3, 6-8, 15, and 43 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Arnold* (U.S. Patent No. 6,275,848 ) in view of *Lafe* (U.S.

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Patent No. 6,449,658). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 1**, as amended, recites:

1. A method for automatically managing an electronic mail server application on a host computer, comprising the steps of:
  - checking an electronic mail message against a predetermined criteria;
  - determining whether the message has been previously compressed;
  - compacting the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed; and***
  - storing the compacted electronic mail message.***

(Emphasis Added)

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the combination of *Arnold* and *Lafe* does not disclose, teach, or suggest at least **compacting the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed, and storing the compacted electronic mail message**. Even if *Arnold* discloses compacting an email message, the message is compacted for preparation for transmission. The compacted email message is not stored for later retrieval. *Lafe* does not cure this deficiency.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 1 is allowable.

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-3, 6-8, 15, and 43 (which depend from independent claim 1) are allowable as a matter of law

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for at least the reason that dependent claims 2-3, 6-8, 15, and 43 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 2-3, 6-8, 15, and 43 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-3, 6-8, 15, and 43 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 2-3, 6-8, 15, and 43 are allowable.

**B. Claims 21-23, 26-28, 30-34 and 44**

The Office Action rejects claims 21-23, 26-28, 30-34 and 44 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Arnold* (U.S. Patent No. 6,275,848 ) in view of *Lafe* (U.S. Patent No. 6,449,658). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 21**, as amended, recites:

21. A method for managing a user's electronic mailbox on a computer, comprising the steps of:

performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria;

*compressing the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns; and*

*storing the compressed electronic mail message.*

(Emphasis Added).

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For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 21 is allowable for at least the reason that the combination of *Arnold* and *Lafe* does not disclose, teach, or suggest at least **compressing the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns; and storing the compressed electronic mail message**. Even if *Arnold* discloses compressing an email message, the message is compressed for preparation for transmission. The compressed email message is not stored for later retrieval. *Lafe* does not cure this deficiency.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 21. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 21 is allowable.

Because independent claim 21 is allowable over the cited art of record, dependent claims 22-23, 26-28, 30-34 and 44 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-23, 26-28, 30-34 and 44 contain all the steps/features of independent claim 21. Therefore, the rejection to claims 22-23, 26-28, 30-34 and 44 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 22-23, 26-28, 30-34 and 44 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 22-23, 26-28, 30-34 and 44 are allowable.

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C. Claims 35-42 and 45

The Office Action rejects claims 35-42 and 45 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Arnold* (U.S. Patent No. 6,275,848 ) in view of *Lafe* (U.S. Patent No. 6,449,658). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 35**, as amended, recites:

35. A computer readable medium with logic embedded therein for executing on a computer for managing a electronic mailbox on a computer comprising:

logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria;

*logic configured to, if the predetermined criteria is satisfied, compress the electronic mail message by finding repeated patterns in the message and encoding those patterns; and*

*logic for storing the compressed electronic mail message.*

(Emphasis Added)

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 35 is allowable for at least the reason that the combination of *Arnold* and *Lafe* does not disclose, teach, or suggest at least **logic configured to, if the predetermined criteria is satisfied, compress the electronic mail message by finding repeated patterns in the message and encoding those patterns; and logic for storing the compressed electronic mail message**. Even if *Arnold* discloses compressing an email message, the message is compressed for preparation for transmission. The compressed email message is not stored for later retrieval. *Lafe* does not cure this deficiency.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 35. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 35 is allowable.

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Because independent claim 35 is allowable over the cited art of record, dependent claims 36-42 and 45 (which depend from independent claim 35) are allowable as a matter of law for at least the reason that dependent claims 36-42 and 45 contain all the steps/features of independent claim 35. Therefore, the rejection to claims 36-42 and 45 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 35, dependent claims 36-42 and 45 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 36-42 and 45 are allowable.

#### IV. Rejections Under 35 U.S.C. §103(a) and *Beyda*

##### A. Claims 1-3, 6-8, 15, and 43

The Office Action rejects claims 1-3, 6-8, 15, and 43 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda* (U.S. Patent No. 6,275,850 ) in view of *Hanson* (U.S. Patent No. 6,549,957). For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 1**, and amended, recites:

1. A method for automatically managing an electronic mail server application on a host computer, comprising the steps of:
  - checking an electronic mail message against a predetermined criteria;
  - determining whether the message has been previously compressed;
  - compacting the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed; and*
  - storing the compacted electronic mail message.*

(Emphasis Added).

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For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the combination of *Beyda* and *Hanson* does not disclose, teach, or suggest at least **compacting the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed; and storing the compacted electronic mail message**. Even if *Beyda* discloses compacting an email message, the message is compacted for preparation for transmission. The compacted email message is not stored for later retrieval. *Hanson* does not cure this deficiency.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 1. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 1 is allowable.

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-3, 6-8, 15, and 43 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-3, 6-8, 15, and 43 contain all the steps/features of independent claim 1. Therefore, the rejection to claims 2-3, 6-8, 15, and 43 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-3, 6-8, 15, and 43 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 2-3, 6-8, 15, and 43 are allowable.

B. Claims 21-23, 26-28, 30-34 and 44

The Office Action rejects claims 21-23, 26-28, 30-34 and 44 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda* (U.S. Patent No. 6,275,850 ) in view of *Hanson* (U.S. Patent No. 6,549,957). For the reasons set forth below, Applicant respectfully traverses the rejection. For the reasons set forth below, Applicant respectfully traverses the rejection.

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**Independent claim 21**, as amended, recites:

21. A method for managing a user's electronic mailbox on a computer, comprising the steps of:

performing an off-peak hours routine for checking an electronic mail message against a predetermined criteria;

*compressing the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns; and*

*storing the compressed electronic mail message.*

(Emphasis Added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 21 is allowable for at least the reason that the combination of *Beyda* and *Hanson* does not disclose, teach, or suggest at least **compressing the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns; and storing the compressed electronic mail message**. Even if *Beyda* discloses compressing an email message, the message is compressed for preparation for transmission. The compressed email message is not stored for later retrieval. *Hanson* does not cure this deficiency.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 21. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 21 is allowable.

Because independent claim 21 is allowable over the cited art of record, dependent claims 22-23, 26-28, 30-34 and 44 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-23, 26-28, 30-34 and 44 contain all the



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steps/features of independent claim 21. Therefore, the rejection to claims 22-23, 26-28, 30-34 and 44 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 22-23, 26-28, 30-34 and 44 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 22-23, 26-28, 30-34 and 44 are allowable.

C. Claims 35-42 and 45

The Office Action rejects claims 35-42 and 45 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Beyda* (U.S. Patent No. 6,275,850 ) in view of *Hanson* (U.S. Patent No. 6,549,957). For the reasons set forth below, Applicant respectfully traverses the rejection. For the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 35**, as amended, recites:

35. A computer readable medium with logic embedded therein for executing on a computer for managing a electronic mailbox on a computer comprising:

logic configured to perform an off-peak hours routine to screen an electronic mail message against a predetermined criteria;

*logic configured to, if the predetermined criteria is satisfied, compress the electronic mail message by finding repeated patterns in the message and encoding those patterns; and*

*logic for storing the compressed electronic mail message.*

(Emphasis Added).

For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features/steps of the claim at issue. Applicant respectfully submits that independent claim 35 is allowable for at least the reason that the combination of *Beyda* and *Hanson* does not disclose, teach, or suggest at least **logic configured**

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to, if the predetermined criteria is satisfied, compress the electronic mail message by finding repeated patterns in the message and encoding those patterns; and logic for storing the compressed electronic mail message. Even if *Beyda* discloses compressing an email message, the message is compressed for preparation for transmission. The compressed email message is not stored for later retrieval. *Hanson* does not cure this deficiency.

As shown above, the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 35. Therefore, the rejection should be withdrawn. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 35 is allowable.

Because independent claim 35 is allowable over the cited art of record, dependent claims 36-42 and 45 (which depend from independent claim 35) are allowable as a matter of law for at least the reason that dependent claims 36-42 and 45 contain all the steps/features of independent claim 35. Therefore, the rejection to claims 36-42 and 45 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 35, dependent claims 36-42 and 45 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 36-42 and 45 are allowable.

#### V. Miscellaneous Issues

New claims 43-45 contain subject matter not disclosed in the references of record.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

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**CONCLUSION**

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, that the response is fully responsive, and that the now pending claims 1-3, 6-8, 15, 21-23, 26-28, and 30-45 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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